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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	86135128
Applicant	Coyotes Ice, LLC
Applied for Mark	COYOTES ICE SPORTS
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE  
TRADEMARK TRIAL AND APPEAL BOARD ON APPEAL**

Mark: COYOTES ICE SPORTS  
Serial No: 86135128  
Appellant: Coyotes Ice, LLC  
Examining Attorney: Donald Johnson

**EX PARTE APPEAL**

**APPELLANT'S BRIEF**

## **CASES CITED**

*AMF Inc. v. American Leisure Prods., Inc.*, 474 F.2d 1403, 177 USPQ 268 (CCPA 1973).

*Amstar Corp v. Domino's Pizza, Inc.*, 614 F.2d 252, 259 (5<sup>th</sup> Cir. 1980).

*Carefirst of Maryland, Inc. v. First Care, P.C.*, 434 F.3d 263, 269 (4<sup>th</sup> Cir. 2006).

*Checkpoint Systems, Inc. v. Check Point Software Technologies Inc.*, 269 F.2d 270, 60 USPQ2d 1609 (3rd Cir. 2001).

*Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 98 USPQ2d 1253 (Fed. Cir. 2011).

*Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713 (Fed. Cir. 2012).

*Electronic Design & Sales Inc. v. Electronic Data Systems Corp.*, 954 F.2d 713, 21 USPQ2d 1388, (Fed. Cir. 1992).

*Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

*Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 U.S.P.Q. 233 (C.C.P.A. 1981).

*Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 1570, 218 USPQ 390, 395 (Fed. Cir. 1983).

*Hewlett-Packard Co. v. Human Performance Measurement Inc.*, 23 USPQ2d 1390, 1396 (TTAB 1991).

*In re Alarmax Distributors, Inc.*, Serial No. 78479366, (TTAB 2007) (not precedential).

*In re Axel Ltd. Co.*, Serial No. 85473757 and 85473765 (TTAB 2014) (not precedential).

*In re Digirad Corporation*, 45 USPQ2d 1841 (TTAB 1998).

*In re Edward M. Shin*, Serial No. 77186384 (TTAB 2009) (not precedential).

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*In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973).

*In re Farm Fresh Catfish Co.*, 231 USPQ 495 (TTAB 1986).

*In re Hub Distributing, Inc.*, 218 USPQ 284 (TTAB 1983).

*In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003).

*In re MCI Communications Corp.*, 21 USPQ2d 1534, 1538-39 (Comm'r Pats. 1991).

*In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985).

*In re Nobody's Perfect, Inc.*, 44 USPQ2d 1054, 1056-57 (TTAB 1997).

*In re Princeton Tectonics, Inc.*, 95 USPQ2d 1509 (TTAB 2010).

*In re Shawnee Milling Co.*, 225 USPQ 747 (TTAB 1985).

*In re Spezielle Communications Systems, GmbH*, Serial No. 75/347,223 (TTAB 2001) (not precedential).

*In re Thor Tech, Inc.*, Serial No. 85667188 (January 26, 2015) (non precedential).

*In re Xelerated AB, assignee of Xelerated Packet Devices, AB*, Serial No. 76134524 (TTAB 2005) (not precedential).

*L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1438 (TTAB 2012).

*Luigino's Inc. v. Stouffer Corp.*, 50 USPQ2d 1047, 1049 (8<sup>th</sup> Cir. 1999).

*National Aeronautics and Space Administration v. Record Chemical Co.*, 185 USPQ 563 (TTAB 1975).

*Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992).

*Palm Bay Imps. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1371, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005).

*Appellant's Brief – Ex parte Appeal* SN: 86135128

*Recot Inc. v. M.C. Becton*, 54 USPQ2d 1894, 1899 (Fed. Cir. 2000).

*Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975).

*Shen Manufacturing. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1245, 73 USPQ2d 1350, 1356-57 (Fed. Cir. 2004).

*Schwarzkopf v. John H. Breck, Inc.*, 340 F.2d 978, 144 USPQ 433 (C.C.P.A. 1965).

*Taco Time Int'l, Inc. v. Taco Town, Inc.*, 217 USPQ 268, 270 (TTAB 1982).

*Visual Info. Inst., Inc. v. Vicon Indus. Inc.*, 209 USPQ 179, 189 (TTAB 1980).

COME NOW, Appellant Coyotes Ice, LLC, by Counsel, and hereby respectfully appeals the Examining Attorney's refusal to register Appellant's applied-for mark.

## **DESCRIPTION OF RECORD**

### **A. PROSECUTION HISTORY**

Appellant filed an application on December 4, 2013 for the mark "COYOTES ICE SPORTS" (with "ICE SPORTS" disclaimed) for "Retail sporting goods stores; Retail stores featuring hockey and figure skating equipment, merchandise and novelties" in Class 35.

Appellant's mark was initially refused registration in an Office Action dated March 18, 2014 for likelihood of confusion with U.S. Registration Nos. 3,655,451 ("W COYOTE"), 3,688,377 ("W COYOTE OUTDOORS") (with "OUTDOORS" disclaimed), and 4,379,914 ("RED COYOTE"); insufficient specimen; an indefinite identification; and requesting a disclaimer of the wording "ICE SPORTS".

Appellant timely responded on September 18, 2014 with arguments, evidence, amendment to the identification of services, and a disclaimer of the wording "ICE SPORTS." The Examining Attorney issued a Final Action on October 16, 2014, maintaining the likelihood of confusion refusal over U.S. Registration Nos. 3,655,451; 3,688,377; and 4,379,914 and the insufficient specimen refusal.

Appellant timely filed a Notice of Appeal and Request for Reconsideration on April 16, 2015 and submitted arguments and further evidence to rebut the likelihood of confusion and specimen refusals. On May 18, 2015, the Examining Attorney denied Appellant's Request for Reconsideration and found the specimen refusal moot because Appellant amended the filing basis to Section 1(b), intent to use. When Appellant's Request for Reconsideration was denied, this Appeal was reinstated. Appellant therefore presently submits this appeal brief.

## **B. REQUEST FOR RELIEF**

Appellant respectfully requests the Board to find Appellant's mark does not present a likelihood of confusion with the cited marks and should be published for Class 35.

## **C. SUMMARY OF THE EVIDENCE**

Because both parties submitted considerable evidence, Appellant is providing the following summary of the evidence for the Board's convenience.

### **1. EXAMINING ATTORNEY'S EVIDENCE**

The Examining Attorney submitted three website links at [www.dicksportinggoods.com](http://www.dicksportinggoods.com), [www.big5sportinggoods.com](http://www.big5sportinggoods.com), and [www.sportsauthority.com](http://www.sportsauthority.com) to the March 18, 2014 Office Action. Further, the Examining Attorney submitted definitions of "COYOTE" at <http://www.vocabulary.com/dictionary/coyote> and <http://www.merriam-webster.com/dictionary/coyote>. The Examining Attorney submitted seven website links to different companies that show outdoor skating rinks in the October 16, 2014 Final Office Action and several third party registrations to show a connection between retail sporting goods stores and on-line retail stores featuring sporting goods.

### **2. APPELLANT'S EVIDENCE**

In response to the Office Action of March 18, 2014, Appellant included website evidence at [www.wcoyoteoutdoors.com](http://www.wcoyoteoutdoors.com) demonstrating use of the marks in U.S. Registration Nos. 3,655,451 and 3,688,377. Appellant also submitted three other websites featuring the difference between gun and fishing manufacturers and those that construct hockey and figure skating equipment at <http://www.hockeygiant.com/ice-hockey-skates-senior-ice-hockey-skates---sizes-6---up.html>, <http://www.wcoyoteoutdoors.com/KNIVES-and-TOOLS.html>, and

<http://www.wcoyoteoutdoors.com/SHOOTING-ACCESSORIES.html>. Appellant further submitted seven websites that showed examples of teams which compete under the nickname “COYOTES.”

Further, in the Request for Reconsideration of April 16, 2015, Appellant submitted evidence of four website links featuring ice sports which were not restricted to the outdoors.

#### **D. LEGAL STANDARD**

Likelihood of confusion between two marks is determined on a case-by-case basis by a review of all relevant factors under the *DuPont* test. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973). The two key considerations in ex parte likelihood of confusion analysis are the similarity of the marks and the similarity of the goods. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). Not all of the *DuPont* factors may be relevant or of equal weight in a given case, and any one of the factors may control a particular case depending on the evidence of record. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1355, 98 USPQ2d 1253, 1260 (Fed. Cir. 2011); *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); *see In re E. I. du Pont de Nemours & Co.*, 476 F.2d at 1361-62, 177 USPQ at 567. To uphold a “likelihood of confusion” refusal, the evidence must show the *likelihood* of confusion and not merely the *possibility* of confusion. *Electronic Design & Sales Inc. v. Electronic Data Systems Corp.*, 954 F.2d 713, 21 USPQ2d 1388, 1393 (Fed. Cir. 1992).

When weighing all *DuPont* factors, the evidence shows that a likelihood of confusion is unlikely. The most relevant factors to be considered in the present instance are: (1) the nature and extent of actual confusion and the length of time the marks have been concurrently used without evidence of actual confusion; (2) the dissimilarity of the appearance, sound, connotation, and commercial impression; and (3) the dissimilarity and nature of the goods and services and dissimilarity of trade channels. Consideration of the relevant factors shows that confusion is unlikely because there have not been any



instances of actual confusion between Appellant's mark and the cited marks throughout the five years of concurrent use. Also, Appellant's "COYOTES ICE SPORTS" mark is sufficiently dissimilar from the cited stylized "W COYOTE," "W COYOTE OUTDOORS," and "RED COYOTE" marks in sound, pronunciation, connotation and commercial impression. Lastly, Appellant's applied-for goods and services are sufficiently dissimilar from the cited mark's registration that confusion is unlikely because the goods and services would travel through different trade channels and be encountered by different consumers.

Accordingly, Appellant's mark should be moved to publication because no likelihood of confusion exists between Appellant's mark and the cited marks.

#### **E. ANALYSIS**

**3. DuPont Factor 1: Appellant is unaware of any instances of actual confusion between Appellant's mark and Registrant's marks during at least five years of concurrent use.**

Appellant respectfully submits that the Examining Attorney's refusal to register Appellant's "COYOTES ICE SPORTS" mark based on an alleged likelihood of confusion between Appellant's "COYOTES ICE SPORTS" mark and the cited "W COYOTE," "W COYOTE OUTDOORS," and "RED COYOTE" stylized marks does not properly take into account the absence of any actual confusion during the five years of concurrent use. Under *DuPont*, two of the relevant factors to be considered in evaluating a likelihood of confusion are the nature and extent of actual confusion and the length of time the marks have been concurrently used without evidence of actual confusion. *See In re E. I. du Pont de Nemours & Co.*, 476 F.2d at 1361, 177 USPQ at 567. In fact, "the absence of any evidence of actual confusion . . . over a substantial period of time...creates a strong inference that there is no likelihood of confusion." *Carefirst of Maryland, Inc. v. First Care, P.C.*, 434 F.3d 263, 269 (4<sup>th</sup> Cir. 2006).

Appellant's mark and the cited marks have been used concurrently for at least five years without any indication of actual confusion, and thus it is unlikely that consumers would be confused by the

relevant marks. As evidenced in the record, “W COYOTE” has been used since June 15, 2006, “W COYOTE OUTDOORS” has been used in commerce since at least May 1, 2008, and “RED COYOTE” has been used since at least March 29, 2010. Appellant has been using “COYOTES ICE SPORTS” since at least January 15, 2000. In over five years of concurrent use (and Appellant’s use for over 15 years), there has been no evidence of any confusion between the marks.

This concurrent use for over five (5) years without any known instances of actual confusion strongly suggests that future confusion is unlikely.

**4. DuPont Factor 2: Appellant’s mark and Registrant’s mark are sufficiently dissimilar in appearance, sound, connotation, and commercial impression such that no likelihood of confusion exists.**

Appellant respectfully submits that the Examining Attorney’s refusal to publish Appellant’s mark based on an alleged likelihood of confusion with the cited marks is in error. The Examining Attorney’s decision does not properly take into account the weakness of the “COYOTE” element of the marks as well as differences in appearance, sound, connotation, and commercial impression between the marks and therefore should be reversed.

When analyzing marks, “[t]he proper test is not a side-by side comparison of the marks, but instead ‘whether the marks are sufficiently similar in terms of their commercial impression’ such that persons who encounter the marks would be likely to assume a connection between the parties.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (citation omitted). The focus is on the recollection of the average purchaser, who normally retains a general rather than specific impression of trademarks. *L’Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1438 (TTAB 2012); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975).

Here, the Examining Attorney has not given adequate consideration to the dissimilarity of the marks in appearance, sound, connotation and commercial impression, as required. Appellant respectfully

submits that the cited marks are sufficiently different from Appellant's "COYOTES ICE SPORTS" mark that no likelihood of confusion exists.

**i. The "COYOTE" portion of the cited marks is weak.**

The shared "COYOTE" element of the marks cited against Appellant is diluted and weak in relation to sports or sports teams and thus should not be given much weight in a likelihood of confusion analysis. The strength and distinctiveness of a mark is a vital consideration in determining the scope of protection a mark is accorded, with stronger marks being more widely protected than weaker marks. *See Amstar Corp v. Domino's Pizza, Inc.*, 614 F.2d 252, 259 (5<sup>th</sup> Cir. 1980). Further, the Board has held that when portions of a mark are pronounced the same or look similar, determining whether the marks are similar lies in focusing on the strength of the cited marks and determining whether they are entitled to a broad or limited scope of protection. *In re Xelerated AB*, Serial No. 76134524 (TTAB 2005) at \*6 (not precedential).

The record shows that the common element "COYOTE" is diluted in relation to sports teams and equipment, and thus is not entitled to broad protection. Specifically, the "COYOTE" element is diluted and has very little power as a source identifier in connection with sports equipment sold by retail stores because it is such a common nickname for teams affiliated with sports. Appellant submitted at least seven sports team names to the record that use the common element "COYOTE" in their names. (Office Action Response, September 29, 2014, p. 4). This evidence demonstrates that others who appear to be unrelated to Registrants of the cited marks use the "COYOTE" element in association with sports retailers, who often sell sports team merchandise in connection with those sports teams. Thus, the "COYOTE" element shared by the cited marks has little power as a source identifier and thus should be accorded only limited protection. Further, the purchasing public has been exposed to the use of "COYOTE" or "COYOTES" in connection with sports teams and their sports equipment sold by sports retailers, and thus and will not look to that portion of a mark as a source identifier.

The weak “COYOTE” portion of the cited marks should be given less weight in the comparison of the marks and should not be afforded a broad scope of protection. The fact that the Examining Attorney was able to cite several marks for retail store services featuring sporting goods using the element “COYOTE” in their marks only further demonstrates that consumers are less likely to focus on the “COYOTE” portion of the mark. (See Office Action, March 18, 2014, p. 11-19). Therefore, since the “COYOTE” portion of the mark is diluted and weak, purchasers will look to other more dominant elements of the mark to distinguish source, and thus confusion is unlikely.

**ii. There are significant differences in sound and appearance between Appellant’s mark and the cited marks.**

The appearance of Appellant’s “COYOTES ICE SPORTS” mark (with “ICE SPORTS” disclaimed) is significantly different from the cited “W COYOTE,” “W COYOTE OUTDOORS,” and “RED COYOTE” design marks because the disclaimed portion of the marks should be considered and the dominant portion of the marks is the more visually distinct portion, not the weakened “COYOTE” element.

When analyzing the marks, the Examining Attorney must consider the difference in sound and meaning of the marks. *See Palm Bay Imps. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1371, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (citing *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973). It is the overall impression created by the mark that is critical and not merely a comparison of certain individual elements. *Luigino’s Inc. v. Stouffer Corp.*, 50 USPQ2d 1047, 1049 (8<sup>th</sup> Cir. 1999) (emphasis added). Further, “all relevant facts pertaining to appearance, sound, and connotation must be considered before similarity as to one or more of these factors may be sufficient to support a finding that the marks are similar or dissimilar.” *Recot Inc. v. M.C. Becton*, 54 USPQ2d 1894, 1899 (Fed. Cir. 2000) (in which the Board erroneously only considered connotation and not appearance or overall sound of the marks “FIDO LAY” and “FRITO-LAY”) (emphasis added).

When there are similarities between marks, the presence of similarities alone is not sufficient to show a likelihood of confusion when there are plain differences between the two marks. *See, e.g. Taco Time Int'l, Inc. v. Taco Town, Inc.*, 217 USPQ 268, 270 (TTAB 1982) (“While the words ‘TIME’ and ‘TOWN’ have obvious similarities (both words begin with the letter ‘T’, both have one syllable and four letters), there are significant differences between these words. They are pronounced differently, have different appearances, and different meanings.”).

When the marks are considered as a whole for their overall impression and all relevant facts pertaining to appearance and sound are taken into account, there are plain differences between Appellant’s “COYOTES ICE SPORTS” mark and the cited “W COYOTE,” “W COYOTE OUTDOORS” and “RED COYOTE” marks. Appellant respectfully submits that: (1) the Examining Attorney gave too little weight to the disclaimed portions of the marks, and (2) the Examining Attorney placed too much weight on common material and did not consider the mark as a whole.

1. *The Disclaimed Portion of the Marks Must Be Considered.*

Appellant respectfully submits that the disclaimed portion of the mark must be considered. The Examining Attorney gave too little weight to the disclaimed portions of the “COYOTES ICE SPORTS” mark and the cited marks. Likelihood of confusion is determined by the likely reaction of ordinary purchasers who do not know about disclaimers, because a disclaimer does not remove the disclaimed matter from the mark. *Giant Food, Inc. v. Nation’s Foodservice, Inc.*, 710 F.2d 1565, 1570, 218 USPQ 390, 395 (Fed. Cir. 1983); *Schwarzkopf v. John H. Breck, Inc.*, 340 F.2d 978, 144 USPQ 433 (C.C.P.A. 1965); *In re MCI Communications Corp.*, 21 USPQ2d 1534, 1538-39 (Comm’r Pats. 1991); *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985); *see also, Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 U.S.P.Q. 233 (C.C.P.A. 1981) (“It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion.”).

Here, the Examining Attorney gave no weight to the disclaimed portion Appellant's mark "ICE SPORTS." When Appellant's mark is considered as a whole including the disclaimed matter, Appellant's entire mark is "COYOTES ICE SPORTS" and consists of three separate components: the plural word "COYOTES," the word "ICE" and the word "SPORTS." Further, Appellant's mark is rendered visually distinct by the length of the mark and its use of different words from the "W COYOTE," "W COYOTE OUTDOORS," and "RED COYOTE" stylized marks. The cited marks, in contrast, consist of singular forms of "COYOTE" with the dominant and visually distinct portions being "W" and "RED." The cited marks only have a singular "COYOTE" which signifies the difference between reference to a single source or animal when compared to "COYOTES" which connotes a sports or team affiliation (as explained in more detail below).

Therefore, Appellant respectfully submits that the "ICE SPORTS" portion of Registrant's mark sufficiently distinguishes it both visually and in sound from the cited marks. The differences in appearances between the two marks support a finding that confusion is unlikely.

## *2. The Dominant Portions of the Marks are the Undiluted Elements*

Appellant respectfully submits that the dominant portions of the marks is not the "COYOTE" element, which is diluted in respect to sports equipment in sports retail stores, but instead the undiluted portions of the marks. Additions to marks can be sufficient to avoid likelihood of confusion if the matter common to the marks is not likely to be perceived by purchasers as distinguishing source because it is merely diluted. See, e.g., *Shen Manufacturing. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1245, 73 USPQ2d 1350, 1356-57 (Fed. Cir. 2004) (reversing TTAB's holding that contemporaneous use of THE RITZ KIDS for clothing items (including gloves) and RITZ for various kitchen textiles (including barbeque mitts) is likely to cause confusion, because, *inter alia*, THE RITZ KIDS creates a different commercial impression) (emphasis added).

As in *Shen Manufacturing.*, the dominant portion of the marks is not the shared “COYOTES” portion because “COYOTES” is diluted with respect to sports or sports teams. Thus, consumers look to other portions of the mark in determining source identity. Therefore, additions to the marks such as “ICE SPORTS” are sufficient to avoid likelihood of confusion.

Similarly, the dominant portions of the marks are undiluted elements. Specifically, the dominant portion of the cited marks are the “W” in “W COYOTE” and “W COYOTE OUTDOORS” and the “RED” in “RED COYOTE.” These are the portions that consumers are most likely to focus on. Moreover, there are clear visual differences between the undiluted elements of the cited design marks and Appellant’s mark “COYOTES ICE SPORTS.” The stylized elements of a design mark should still be considered when viewing a mark as a whole. When considered as a whole, the largest portion of the cited mark “RED COYOTE” is the running fox logo that is about five times larger than the literal element of the mark. Also, when considered as a whole, the “W” for “W COYOTE” and “W COYOTE OUTDOORS” is also the largest portion of the cited marks and the most visually distinctive since it appears as a large cursive “W.” It follows that a consumer would focus on the logo to distinguish source and not the literal “COYOTE” portion of the “RED COYOTE” mark which is smaller and at the end of the mark. As established earlier, consumers are exposed to innumerable sports teams using “COYOTE” with emblems, mascots, and sports equipment sold by sports retailers and would thus look to these visually distinct and undiluted portions of the cited marks to distinguish source. Simply put, consumers are more likely to focus on the “W,” “OUTDOORS,” “RED,” and “ICE SPORTS” portions of the relevant marks, which are dissimilar from each other.

The Examining Attorney erred in giving too much to the diluted “COYOTE” portion of the marks and no weight to the dominant portions of the marks. These differences in appearance and sound between the dominant portions of the marks make confusion unlikely.

**iii. There are significant differences in connotation and commercial impression between the Appellant's marks and the cited marks.**

Further, supporting a conclusion that confusion is unlikely and in addition to the differences in appearance and sound between the marks at issue, Appellant's mark and the cited marks have significant differences in connotation and commercial impression when applied to the respective parties' goods and services.

As the Board has frequently noted, marks may contain elements in common and still not create consumer confusion if the marks as a whole create different commercial impressions. See, e.g. *In re Farm Fresh Catfish Co.*, 231 USPQ 495 (TTAB 1986) (CATFISH BOBBERS (with "CATFISH" disclaimed) for fish held not likely to be confused with BOBBER for restaurant services); *In re Shawnee Milling Co.*, 225 USPQ 747 (TTAB 1985) (GOLDEN CRUST for flour held not likely to be confused with ADOLPH'S GOLD'N CRUST and design (with "GOLD'N CRUST" disclaimed) for coating and seasoning for food items). In determining whether two marks give the same commercial impression, the question is whether the marks create the same overall impression. See *Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 1329-30, 54 USPQ2d 1894, 1899 (Fed. Cir. 2000); *Visual Info. Inst., Inc. v. Vicon Indus. Inc.*, 209 USPQ 179, 189 (TTAB 1980). The focus is on the recollection of the average purchaser, who normally retains a general rather than specific impression of trademarks. *L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1438 (TTAB 2012); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975).

In determining overall commercial impression, the Federal Circuit and the Board have found no likelihood of confusion based on the difference in connotation and commercial impression in cases where the marks were more similar than the marks at issue here. For example, in *In re Digirad Corporation*, the Board held that "DIGIRAY" is not confusingly similar to "DIGIRAD" because the "RAY" portion of DIGIRAY connotes an "x-ray" and the "RAD" portion of DIGIRAD connotes "radiation." *In re Digirad Corporation*, 45 USPQ2d 1841 (TTAB 1998). Also, in *In re Nobody's Perfect, Inc.*, the Board found that



no likelihood of confusion exists between “NOBODY’S PERFECT” and “NO BODY’S PERFECT” marks based on difference in connotation, notwithstanding substantial phonetic and visual similarities in the respective marks and the closely related nature of the goods and services. *In re Nobody’s Perfect, Inc.*, ( 44 USPQ2d 1054, 1056-57 (TTAB 1997). *See also, In re Spezielle Communications Systems, GmbH*, Serial No. 75/347,223 (TTAB 2001) (non precedential) (“PACTOR” sufficiently differently from “PICTOR” since “PACTOR” relates to data packets and “PICTOR” relates to digital pictures); *In re Edward M. Shin*, Serial No. 77186384 (TTAB 2009) (non precedential) (Wi-Notifi” sufficiently different from WeNotify based on the connection of Wi-Notifi with “wi-fi” for telecommunications services).

In *In re Digirad Corporation*, the Board held that even though “DIGIRAY” and DIGIRAD” were visually similar, the connotations of “RAY” and “RAD” were not similar. 45 USPQ2d 1841 (TTAB 1998). The marks at issue in this case are more dissimilar in appearance than “DIGIRAY and “DIGIRAD,” which only differed in a single final letter.

Here, “COYOTES ICE SPORTS” is not only visually distinctive from the cited “W COYOTE,” “W COYOTE OUTDOORS,” and “RED COYOTE” marks, but it connotes an entirely different idea- that of a sports team or group affiliation because of its plural form and an ice sport or winter sport because of “ICE SPORTS.” Specifically, the “ICE SPORTS” portion of the mark invokes a connection to selling hockey and figure skating equipment since it is related to “ice” and the concept of cold weather sports. “W COYOTE,” “W COYOTE OUTDOORS,” and “RED COYOTE” do not create this commercial impression whatsoever, but instead, merely suggest a source of outdoor goods or a source of fitness services (as based on the “RED COYOTE” running fox logo).

The record contains ample evidence to demonstrate the different connotations and commercial impressions between Appellant’s “COYOTES ICE SPORTS” and the cited marks are such that the overall impressions of the marks are significantly different. For example, Appellant has presented evidence of at least seven sports teams that operate under plural noun nicknames and not any singular

noun nicknames (Office Action Response, September 18, 2014, 4, citing to “Casper Coyotes,” “Kankakee Coyotes,” “Cape Cod Coyotes,” “Richmond Hill Coyotes,” “Coyotes Field Hockey,” “Minnesota Coyotes” and “AZ Lady Coyotes”). The evidence shows that plural nouns are commonly used to identify sports teams, whereas singular nouns like “COYOTE” or “CARDINAL” are not. All three cited marks contain a singular form “COYOTE” and no indication of sports, sports teams, or a group affiliation as Appellant’s “COYOTES ICE SPORTS” does. Further, Appellant submitted screenshots and website links as evidence that “W COYOTE” and “W COYOTE OUTDOORS” are used in conjunction with selling binoculars, high end riflescopes, archery equipment, guns, ice fishing equipment, and many other outdoors equipment for “the outdoor enthusiast.” (Office Action Response, September 18, 2014, p. 3). The website evidence features a page selling “knives and tools,” a page featuring “shooting accessories,” and the main webpage that discusses providing “high end rifle scopes” and “optic accessories.” The website page for shooting accessories even says to “Ask W Coyote” if you know of an outdoor shooting accessory product you would like to see on the website. This demonstrates that both “W COYOTE” and “W COYOTE OUTDOORS” are used in connection with outdoor equipment for hunting and shooting, which creates an entirely different commercial impression, as a member of the purchasing public would not consider “W COYOTE OUTDOORS” related to outdoor equipment to be related to the figure skating equipment and novelties sold by “COYOTES ICE SPORTS.” Simply put, the cited marks do not connote a team affiliation, an ice sport or a winter sport, but instead impresses the idea of “outdoors” activities.

Moreover, the cited mark “RED COYOTE” for computerized on-line stores in the field of running and fitness” connotes a single source for products such as t-shirts, shorts, wind jackets, and warmers because of the singular form “COYOTE” and the running fox logo. In other words, all three cited marks use “COYOTE” in a singular form, which connotes a singular animal. In contrast, “COYOTES” in plural connotes a group or team affiliation such as a sports team. This would be readily

apparent to a member of the purchasing public, who has been exposed to innumerable sports teams, emblems, equipment, and mascots that use the plural form “COYOTES.”

Thus, consumers are unlikely to be confused by Appellant’s mark “COYOTES ICE SPORTS” and the cited marks because, when considered as a whole, consumers would focus on the undiluted portions of the mark instead of the diluted “COYOTE” portion of the mark. Further, once the marks are considered as a whole, there are significant differences in connotation and commercial impression which makes confusion unlikely.

**5. DuPont Factor 3: Appellant’s goods and services are not similar or related to the goods and services covered by Registrant’s marks.**

In regard to the third *DuPont* factor, the goods and services as identified by the marks are not similar or related and do not travel through the same channels of trade. In looking at the dissimilarity of the goods and services, the Board will look at the **registration** applicant is seeking in its application and not its actual use. *In re Axel Ltd. Co.*, Serial No. 85473757 and 85473765 (TTAB 2014) (not precedential) (emphasis added).

When comparing the identifications of the marks, Appellant’s goods and services are retail sporting goods stores and are limited to featuring hockey and ice skating equipment. In contrast, the cited marks are used with goods and services related to online retail stores or computerized on-line retail stores limited to outdoors equipment or fitness services. Confusion is therefore unlikely because the goods and services are not substitutes for each other, do not travel through the same channels of trade, and would be encountered by different purchasers.

**i. Appellant’s goods and services are not similar or related to the cited marks’ goods and services.**

Appellant’s goods and services are not related to the goods and services of the cited marks. The nature and scope of a party’s goods or services must be determined on the basis of the goods or services

recited in the application or registration. *See, e.g., Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1370, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012); *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 1267, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002).

Appellant's seeks registration of "COYOTES ICE SPORTS" in connection with "Retail sporting goods stores; Retail stores featuring hockey and figure skating equipment, merchandise and novelties, namely, hockey helmets, hockey sticks, hockey gloves, hockey pads, hockey pants, hockey socks, hockey stakes, hockey apparel, hockey protective gear, hockey jerseys, hockey masks, hockey novelty items, hockey bags, hockey pucks and training aids, figure skating skates, figure skating apparel, figure skating gloves, figure skating novelty items, figure skating bags" in Class 35 (emphasis added). Appellant's retail sporting goods store limited to featuring hockey and figure skating equipment is thoroughly unrelated to the cited marks.

For example, Registrant of the cited mark "W COYOTE OUTDOORS" uses its mark in connection with "Bandanas; Belts; Boots; Caps; Gloves; Jackets; Pants; Shirts; Shoes; Shorts; Socks; T-shirts; Vests" in Class 25 and "online retail store services featuring outdoor equipment and sports goods" in Class 35. It also uses its mark "W COYOTE" in connection with "retail sporting goods stores" in Class 35. This online retail store services limited to outdoor equipment are simply not the same as Appellant's retail stores featuring hockey and figure skating equipment such as hockey protective gear, hockey masks, and figure skating bags.

Moreover, Registrant of the "RED COYOTE" uses its mark in connection with "Computerized on-line retail store services in the field of running and fitness; On-line retail store services featuring shirts; t-shirts; singlets; shorts; sports jackets; wind jackets; hats; visors; beanies; arm warmers; Retail apparel stores; Retail sporting goods stores; Retail store services featuring a wide variety of consumer goods of others; Retail clothing stores" in Class 35. Appellant's services do not relate to computerized on-line retail store services in the field of running and fitness. In fact, Appellant's retail stores featuring hockey

and figure skating equipment are significantly different from computerized on-line retail store services, especially in the field of running and fitness.

Therefore, the *DuPont* factor of whether the goods and services of the marks are related weighs in favor of Appellant because retail stores featuring hockey and figure skating equipment is different from online retail store services featuring outdoor equipment, retail sporting goods stores that are not limited to hockey and figure skating equipment, or computerized on-line retail stores services in the field of running and fitness.

Therefore, because Appellant's goods and services and the goods and services of the cited marks are not similar or related, confusion between their respective marks is unlikely.

**ii. Appellant's trade channels are dissimilar from the cited marks' trade channels and their products are not substitutes for each other.**

Appellant goods and services travel through different trade channels and are encountered by a different target market because their products are not substitutes for each other.

The Federal Circuit has held that even when the goods and services operate in the same field they may not be sold to the same relevant persons and may or may not be substitutes for each other. *See Checkpoint Systems, Inc. v. Check Point Software Technologies Inc.*, 269 F.2d 270, 60 USPQ2d 1609 (3rd Cir. 2001) ("Plaintiff's sphere includes physical security and control of flow of corporate goods and people...Defendant's sphere includes electronic information security on computer networks that the point of connection to the Internet and within the customer's intranet. Their products are not substitutes for each other...[Their products] are advertised in different magazines and are promoted in entirely different trade shows.") (emphasis added). Further, the Board and Federal Circuit have held that, even when services are related, they may travel through different channels of trade. *See, e.g. In re Alarmax Distributors, Inc.*, Serial No. 78479366, (TTAB 2007) \*12-13 (not precedential); *Electronic Design & Sales Inc. v. Electronic Data Systems Corp.*, 954 F.2d 713, 21 USPQ2d 1388, 1391 (Fed. Cir. 1992) (even

when parties conduct business in the same fields, this does not by itself establish similarity of trade channels).

Appellant's goods and services differ from the cited marks' goods and services more than in *Checkpoint Systems, Inc.* because Appellant's products and the products on which the cited marks are used would not be substitutes for each other. Instead, Registrants of "RED COYOTE" and "W COYOTE OUTDOORS" market their outdoor equipment and sporting goods and its running and fitness services and merchandise exclusively online. The Registrant of "RED COYOTE" uses its mark specifically in connection with "computerized on-line retail store services" and Registrant of "W COYOTE OUTDOORS" uses its mark specifically with "online retail store services" in Class 35. Appellant does not operate online retail store services, but instead operates retail stores specifically limited to hockey and figure skating equipment. Therefore, these services are not substitutes for each other and would be marketed in different channels and encountered by separate consumers, making confusion unlikely.

Moreover, Registrant of the "RED COYOTE" mark uses its mark in connection with computerized on-line retail *store services* in the field of running and fitness, whereas Appellant uses its mark "COYOTES ICE SPORTS" in connection with retail *stores* featuring hockey and figure skating equipment. The marks in U.S. Registration Nos. 3,688,377 ("W COYOTE OUTDOORS") and 4,379,914 (RED COYOTE) limit their marketing channels to online or on-line retail stores. The use of "RED COYOTE" is further limited to customers who go online for running and fitness services. Appellant's limitation to retail stores featuring hockey and figure skating equipment is not minor and sufficiently distinguishes Appellant's goods and services from the cited marks. Appellant sells hockey and figure skating equipment, merchandise, and novelties through its retail stores. The cited marks "W COYOTE," "W COYOTE OUTDOORS," and "RED COYOTE" do not have this limitation to hockey and figure skating equipment. Moreover, consumers who wish to purchase hockey and figure skating equipment would not look to online stores or websites featuring outdoor sporting goods for hunting or running and or

online services for running and fitness. These services are not substitutes for each other and would not be marketed through the same trade channels. It is unlikely that they are competitors and therefore confusion between their marks is more unlikely.

Accordingly, Appellant respectfully submits that the goods and services identified in connection with the marks of Appellant and Registrant are not similar, do not travel through the same channels of trade, and would not be encountered by the same consumers.

The Examining Attorney alleges that “retail sporting goods stores” and “on-line retail store services featuring sporting goods” emanates from a single source and provides a number of third party registrations as evidence that entertainment and ice hockey games are the kind that emanate from a single source. Appellant respectfully disagrees. Third party registrations by themselves are entitled to little weight on the question of likelihood of confusion. *Olde Tyme Foods Inc. v. Roundy’s Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992); *In re Hub Distributing, Inc.*, 218 USPQ 284 (TTAB 1983). Third party registrations are also not evidence of what happens in the marketplace and do not show that the public is familiar with the use of those marks. *AMF Inc. v. American Leisure Prods., Inc.*, 474 F.2d 1403, 177 USPQ 268 (CCPA 1973); *National Aeronautics and Space Administration v. Record Chemical Co.*, 185 USPQ 563 (TTAB 1975).

In fact, the Board has found that third party registrations have limited or no probative value when the products or services listed in the respective descriptions of goods are different. *See In re Thor Tech, Inc.*, Serial No. 85667188 (January 26, 2015) (non precedential) (emphasis added) (third party registrations showing marks in connection with land motor vehicles and towable recreational vehicle trailers only showed businesses in the industry were distinct enough to avoid confusion even with identical marks); *In re Princeton Tectonics, Inc.*, 95 USPQ2d 1509 (TTAB 2010) (third party registrations provided by the Examining Attorney were not probative to show personal head lamps and electronic lighting fixtures are related since the registrations also identified other goods); *In re Digirad Corporation*,

45 USPQ2d 1841 (TTAB 1998) (third party registrations submitted by the Examining Attorney were not probative because not a single one included both parties goods and were limited to one party's goods).

Similar to the above cases, few if any of the current third party registrations submitted by the Examining Attorney in the record have any probative value to show that retail sporting goods stores and online retail stores emanate from a single source. Specifically, the third party registrations identify a diversity of goods ranging from retail shop window display arrangement services, fitness equipment and nutritional products, horseback riding, and computerized on-line retail store services, which are not related to Appellant's goods and services. (See Office Action, October 16, 2014, p. 11-38) .Thus, there is little chance of confusion between Appellant's mark and Registrant's mark because the predominant purchasers of the services associated with them are different.

Accordingly, Appellant respectfully submits that the goods and services identified in connection with the marks of Appellant and the cited marks do not overlap because they target different markets and would be encountered by different consumers. Further, the goods and services are not substitutes for each other. . Therefore, the *DuPont* factors analyzing the similarity of the goods and services provided by each party and the differing trade channels they will travel through supports a finding that confusion is unlikely between Appellant's mark and the cited marks.

#### **F. CONCLUSION**

When considered as a whole, all factors strongly favor a finding that Appellant's mark is not confusingly similar to the cited marks in U.S. Registration No. 3,655,451; 3,688,377; and 4,379,914 because (1) there has not been any known instance of actual confusion after five years of concurrent use; (2) the marks are sufficiently dissimilar in appearance, sound, connotation, and commercial impression; and (3) the respective goods and services and their respective trade channels are dissimilar. The Examining Attorney's has not met his or her burden to demonstrate that Appellant's mark is confusingly



similar to Registrant's mark. To the extent there exists any doubt in weighing the relevant factors; the Board resolves any such doubt in favor of appellant.

In light of the above, Appellant respectfully requests that the Board grant this Ex Parte Appeal and allow for the publication of Appellant's mark.

Respectfully submitted,

July 20, 2015  
Date

/Steven J. Laureanti/signed  
Steven J. Laureanti, Registration No. 50,274

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